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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,262	09/11/2003	Takahiro Moro	00862.001703.2	3540

5514 7590 05/09/2007
FITZPATRICK CELLA HARPER & SCINTO
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EXAMINER

POON, KING Y

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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05/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/659,262	Applicant(s) MORO ET AL.	
	Examiner King Y. Poon	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/768,579.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 87, 89-92, 94-97, 99-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hower, Jr. et al (US 5,467,434) in view of DeHority (US 5,267,727).

Regarding claims 87, 92, 97: Hower teaches an information processing apparatus (fig. 2) connected with a printer (12-1, fig. 2) comprising: a display unit (column 4, lines 15-25), adapted to display a window for accepting a print setting (print job settings, column 4, lines 25-20); a first determination unit, adapted to determine whether or not a first setting a first setting item in the window is changed (see fig. 4, user is allow to select different, size, clearly the system must be able to determine the input of e.g., 8.5x14 to 8.4x14 such that paper stock would be correctly displayed, fig. 4; i.e., by the input of the user selection changes the first setting to user's selection); a change unit (the program that display LOGO, Plain, column 7, lines 45-50 such that the user can instruct the change to LOGO corresponding to the change of paper size, fig. 11), adapted to, when it is determined a mismatch, display a window on which the user is allowed to enter a selection and when the user enters a selection to change the setting of the second setting item, changes the setting the second setting item

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corresponding to the changed setting of the first setting item (the system is using the user change method of changing LOGO or PLAIN or TAB to match the selected paper size, fig. 11, column 7, lines 45-50), or alternatively the user should not make the selection, changes the setting of the second setting item (the system is using the automatically substitute method of changing LOGO or PLAIN or TAB to match the selected paper size, fig. 11, column 7, lines 50-55), corresponding to the changed setting value of the first setting item without displaying the window on which the user is allowed to enter a selection.

Note: the display of impermissible choice of column 7, lines 40-55 is obvious that it is telling the user that the original selection is not allowed and to allowed the user to reprogram the selections if the user wants to print the print job; also see column 1, lines 50-55.

Howser does not teach second determination unit, adapted to, when it is determined by the first determination unit that the setting of the first item is changed, determine whether a selection of the setting of a second setting item should be made by a user corresponding the changed setting of the first setting item, and when it is determined by the second determination unit that the user should make the selection and when user does not enter a selection to change the setting of the second setting items, does not change the setting of the second setting item corresponding to the changed setting of the first setting item.

DeHority, in the same area of changing user selected instruction of a print job such that user's print job would be successfully carried out, teaches a determination

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unit, adapted to, when it is determined that the setting of the first item is changed, determine whether a selection of the setting of a second setting item should be made by a user corresponding the changed setting of the first setting item (column 3, lines 50-55; notified user=user allowed to change, substitute=user not allowed to change at the time of substitution), and when it is determined by the second determination unit that the user should make the selection and when user does not enter a selection to change the setting of the second setting items, does not change the setting of the second setting item corresponding to the changed setting of the first setting item (no go, column 4, lines 35-39).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower to include: second determination unit, adapted to, when it is determined by the first determination unit that the setting of the first item is changed, determine whether a selection of the setting of a second setting item should be made by a user corresponding the changed setting of the first setting item, and when it is determined by the second determination unit that the user should make the selection and when user does not enter a selection to change the setting of the second setting items, does not change the setting of the second setting item corresponding to the changed setting of the first setting item.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower by the teaching of DeHority because: 1) it would provide flexibility to the system, column 1, lines 40-45, DeHority; 2) it would

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not have wasted user's time, column 1, lines 40-45, DeHority; and 3) it is advantages of doing so, column 2, lines 30-35, DeHority.

Regarding claims 89, 94, 99: Hower teaches acquisition unit, adapted to acquire link information (the software that is accessing the rules about combination of print instructions selection, column 5, lines 40-67, column 6) regarding the changed setting when the setting value of the first setting item is determined to be changed.

Regarding claims 90, 95, 100: Hower teaches wherein the link information contains information instructing that a first setting of the second setting item is unable to be changed and information instructing that a second setting of the second setting item is selected (impermissible combination, column 7, lines 35-40).

Regarding claims 91, 96, 101: Hower teaches an acquisition unit, adapted to acquire link information (the software that is accessing the rules about combination of print instructions selection, column 5, lines 40-67, column 6) regarding the changed setting when the setting of the first setting item is determined to be changed; and a comparison unit, (column 7, line 35-36) adapted to compare the link information acquired by said acquisition unit and a setting, wherein said change unit changes the setting of the second setting item corresponding to the changed setting of the first setting item if the link information differs from the setting (substitute automatically, column 7, lines 50-55).

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3. Claims 88, 93, 98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hower, Jr. et al (US 5,467,434) in view of DeHority (US 5,267,727) as applied to claims 87, 92, 97 above, and further in view of Ito (US 5,130,757).

Regarding claims 88, 93, 98: Hower and DeHority do not disclose wherein the first setting item includes a medium type and second setting item includes a paper feed method.

Ito, in the same area of selecting paper type for printing, teaches selecting a paper feeding method (automatic mode or manual mode, column 2, lines 10-25) and when the elected paper for printing is not presented in the paper feeder, automatic mode is not allowed (column 2, lines 20-25, column 9, lines 20-25) and mismatch is indicated.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower by introducing a paper feed method such as manual feed or auto feed and when the paper selected for printing is not presented and auto mode is selected, a mismatch is informed to the user such that a user would made the changes.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower by the teaching of Ito because: 1) adding an auto feed mode would reduce the effort of the user especially in printing thousands of paper, and provide a printing system with improved efficiency of operation as taught by Ito, column 1, lines 20-26 and 2) it would also prevent printing on paper of a type different from that desired by the operator (column 1, lines 49-52, Ito).

Response to Arguments

4. Applicant's arguments filed 2/15/2007 have been fully considered but they are not persuasive.

The amendment to the claims filed 2/15/2007 has overcome the 112 first paragraph and 112 second paragraph rejections.

With respect to applicant's argument Hower does not teach " at least that when it is determined that a user should make a selection of the setting of a second setting item, displaying a window on which the user is allowed to enter a selection, and when the user does not enter a selection to change the setting of the second setting item, not changing the setting of the second setting item corresponding to a changed setting of a first setting item, as is recited in each of the independent claims" has been considered.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Hower does not teach second determination unit, adapted to, when it is determined by the first determination unit that the setting of the first item is changed, determine whether a selection of the setting of a second setting item should be made by a user corresponding the changed setting of the first setting item, and when it is determined by the second determination unit that the user should make the selection

and when user does not enter a selection to change the setting of the second setting items, does not change the setting of the second setting item corresponding to the changed setting of the first setting item.

DeHority, in the same area of changing user selected instruction of a print job such that user's print job would be successfully carried out, teaches a determination unit, adapted to, when it is determined that the setting of the first item is changed, determine whether a selection of the setting of a second setting item should be made by a user corresponding the changed setting of the first setting item (column 3, lines 50-55; notified user=user allowed to change, substitute=user not allowed to change at the time of substitution), and when it is determined by the second determination unit that the user should make the selection and when user does not enter a selection to change the setting of the second setting items, does not change the setting of the second setting item corresponding to the changed setting of the first setting item (no go, column 4, lines 35-39).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower to include: second determination unit, adapted to, when it is determined by the first determination unit that the setting of the first item is changed, determine whether a selection of the setting of a second setting item should be made by a user corresponding the changed setting of the first setting item, and when it is determined by the second determination unit that the user should make the selection and when user does not enter a selection to change the

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setting of the second setting items, does not change the setting of the second setting item corresponding to the changed setting of the first setting item.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Hower by the teaching of DeHority because: 1) it would provide flexibility to the system, column 1, lines 40-45, DeHority; 2) it would not have wasted user's time, column 1, lines 40-45, DeHority; and 3) it is advantages of doing so, column 2, lines 30-35, DeHority.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

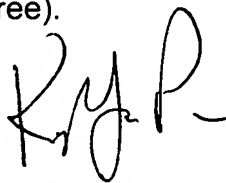
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Y. Poon', with a stylized flourish at the end.

KING Y. POON
PRIMARY EXAMINER

May 4, 2007